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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,367	12/01/2003	Carl Pinsky	9029-7 MIS:jb	8090
24223	7590	08/06/2007		
SIM & MCBURNEY 330 UNIVERSITY AVENUE 6TH FLOOR TORONTO, ON M5G 1R7 CANADA			EXAMINER LEDYNH, BOT L	
			ART UNIT	PAPER NUMBER
			2862	
			MAIL DATE	DELIVERY MODE
			08/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/724,367

Applicant(s)

PINSKY ET AL.

Examiner

Bot LeDinh

Art Unit

2862

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 1-15 and 21-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 16-17 and 20 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Fernandes et al (5436718). Fernandes et al discloses the same invention as claimed. samples concealed in well 23 and remotely located from location (46) of detection. See col. 1, lines 13-40, Figs.1-2.

Claims 16-17 and 20 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Smith (5818231). See col. 10, lines 21-25; Fig.1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandes et al. in view of Hevey (4863876). Fernandes et al discloses substantially the same invention as claimed, except for the substance being in its ground state.

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Moreover, Fernandes et al teaches that “[s]pectroscopy, which is the measurement and interpretation of electromagnetic radiation absorbed or emitted when the molecules, or atoms, of a sample move from one energy state to another, is widely utilized for this purpose.” See col.1, lines 15-20. Hevey (4863876) teaches that when returning to the ground state, excited molecules, atoms, or electrons can radiate energy (col.1, lines 34-59). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Fernandes et al by letting the atoms, molecules, or electrons of the substance return to the ground state as taught by Hevey in order for the excited atoms, molecules, or electrons to radiate energy for measurement purposes. As to claim 19, Fernandes et al does not disclose the substance being chemically-active organic, or radioactive isotope, etc. Given that Fernandes et al relates to the field of spectroscopy and biological research for interpreting the “assay samples for content of various chemicals, hormones, and enzymes,” it is a matter of design choice to use spectroscopy in order to interpret assay samples of radioactive isotope or chemically active organic matter (see col.1, lines 7-20). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Fernandes et al in view of Hevey by employing assay samples of radioactive isotope or chemically active organic substances in order to measure and interpret such substances.

Applicant's arguments with respect to claims 16-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Bot LeDinh whose telephone number is 5712722231. The Examiner normally does not work on Fridays. The examiner can normally be reached on Maxiflex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Lefkowitz can be reached on 5712722180. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



BL/ 2007

Bot LeDinh, J.D., D.A., Ph.D.
Primary Examiner